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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,965	03/25/2004	Raghunath Vitthal Chaudhari	A36200-PCT-USA-A; 066123.	7075
21003	7590	03/05/2007	EXAMINER	
BAKER & BOTTS L.L.P.			OH, TAYLOR V	
30 ROCKEFELLER PLAZA				
44TH FLOOR				
NEW YORK, NY 10112-4498			ART UNIT	PAPER NUMBER
			1625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/808,965	CHAUDHARI ET AL.	
	Examiner	Art Unit	
	Taylor Victor Oh	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, and 11-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Final Rejection

The Status of Claims

Claims 1-8, 11-23 are pending.

Claims 1-8, 11-23 have been rejected.

Specification

The objection of specification has been withdrawn due to the examiner who inadvertently made a mistake in the previous office action.

Claim Objections

The objection of Claim 17 has been withdrawn due to the examiner who inadvertently made a mistake in the previous office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 5-6 under 35 U.S.C. 112, second paragraph, has been maintained due to the partial modification of the claims made in the amendment.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of Claim 13 under 35 U.S.C. 112, first paragraph, has been maintained due to applicants' failure to modify the claim in the amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of Claims 1, 3, 5-10, 14-15, 17, 20, and 23 under 35 U.S.C. 102(b) as being anticipated clearly by Cesa et al (EP 0144118) has been withdrawn to the modification of the claims made in the amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejection of Claims 1-8, 11-23 under 35 U.S.C. 103(a) as being unpatentable over Cesa et al (EP 0144118) in view of Nicholson et al (US 5,744,650) has been maintained.

The rejection of Claims 1-8, 11-23 under 35 U.S.C. 103(a) as being unpatentable over Cesa et al (EP 0144118) in view of Nicholson et al (US 5,744,650) has been maintained with the reasons of record on 6/13/06.

Applicants' Argument

Applicants argue the following issues:

- a. The current invention related to a process for preparation of 2 –hydroxy carboxylic acids overcomes the drawbacks of the prior art processes such as low activity , lack of catalyst stability, use of toxic chemicals, and several operating conditions as seen from paragraph 10 of the specification ;
- b. None of Cesa and Nicholson teach use of the palladium catalysts with specific ligands for preparation of a 2-hydroxy carboxylic acid to achieve the advantages of the present invention, such as increased activity, stability of the catalyst for recycling.

Applicants' arguments have been noted, but the arguments are not persuasive.

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First, regarding the first and second arguments, the Examiner has noted applicant's argument. However, Cesa et al expressly teaches that when using $(\phi_3P)_2PdCl_2$ or $Pd(P\phi_3)_4$ catalyst, other palladium compounds, CH_3CN or/ and tetrahydrofuran can be used together during the reaction process (see col. 4, lines 30-37); from this, there is still a teaching for the organic ligands surrounding palladium catalyst in spite of using the organic ligands slightly different from the claimed invention; these may serve the same purpose as the claimed organic ligands since both have commonly shared the palladium as the core of the catalysts. Moreover, Nicholson et al expressly discloses the general carbonylation process (see col. 46, lines 53-54) in which one or more reactants are reacted in a solvent selected from the group of acetone, methyl ethyl ketone, toluene, and tetrahydrofuran (see col. 34, lines 46-50) in the presence of carbon monoxide and palladium-organopolysphosphite ligand (see col. 7, lines 31-32) containing a halogen, pyridine, triethyl amine, and etc (see col. 8, lines 7-13) to produce a reaction product fluid (see col. 3, lines 21-26). Furthermore, attorney's mere arguments of the advantages of the present invention, such as increased activity, stability of the catalyst for recycling can not take the place of evidence in the record. *In re Deblauwe*, 736 F. 2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). The examiner recommends to file the declaration regarding the unexpected results using the claimed organic ligands in comparison with the ones in the primary prior art in side-by-side data. Therefore, both prior art are still relevant to the claimed invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Taylor victor OH, MSD,LAC
Primary Examiner
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2/28/07